

## REMARKS

After entry of this amendment, claims 1–31 and 47–55 are pending. Claims 6, 10, 11, 13, 14, 26–30, 49–53, and 55 are withdrawn from consideration.

### Amendments to the Claims

Claims 32–46, 56–63, and 67 have been canceled without prejudice.

Claim 52 has been amended to replace “Claim G49” with --Claim 49--, which corrects a typographical error.

### Rejections Under 35 U.S.C. § 103

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### *Rejections over Gentelia and Sleister*

Claims 1–5, 7–9, 12, 15, 17, 18, 21–25, 31, 47, and 48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,201,714 (Gentelia) in view of U.S. Patent No. 5,522,831 (Sleister). The Examiner states that Gentelia discloses, in FIGS. 1 and 4, every feature of the claims except for “a conformable roller, dimensioned and configured for forming a tight seal in the absence of an instrument extending therethrough and for contacting with and conforming to an instrument thereby forming an instrument seal in the presence of the instrument extending therethrough.” The Examiner states that Sleister discloses, in FIGS. 7–9 and in the Specification in col. 8, ll. 39–44, “in order to maintain sufficient pressure against the instrument to prevent gas leakage, the surface of the dynamic seal member of a trocar device must be made from a single elastomer or combination of elastomers”.

Independent claim 1 recites in part a “conformable roller is dimensioned and configured for forming a zero seal in the absence of an instrument extending therethrough, and for contacting with and conforming to an instrument, thereby forming an instrument seal in the presence of the instrument extending therethrough.” The Examiner admits that Gentelia does not disclose the recited conformable roller. As discussed below, Sleister also does not disclose or suggest a conformable roller that forms a zero seal as recited in claim 1. The Examiner cites dynamic seal members 56 as corresponding to the recited conformable roller. In the closed position illustrated in FIGS. 7 and 8, the dynamic seal members 56 together form a 3-mm opening 66, which is not a zero seal. Sleister at 8:2–8. The seal includes a channel seal 72 “so that the channel is absolutely sealed when no surgical instrument is in the cannula 12.” Sleister at 7:7–9. Accordingly, in the closed position, the channel seal 72 forms a zero seal, not the dynamic seal members 56. Because Gentelia and Sleister do not disclose or suggest every feature recited in claim 1, claim 1 is non-obvious over the cited combination. Because claims 2–5, 7–9, and 12 are dependent on claim 1 and recite additional features, these claims are also allowable over the cited references for at least the same reason.

Independent claim 15 recites in part a “roller being sized and configured to form a zero seal in the absence of the instrument, and to contact with and conform to the instrument, thereby forming an instrument seal therewith in the presence of the instrument.” Although the Examiner did not directly address the merits of claim 15, Applicants note that, as discussed above, Sleister does not disclose or suggest the recited feature. Gentelia also does not disclose or suggest the feature. Because the cited combination does not disclose or suggest every feature recited in claim 15 or in claims 17, 18, or 21–23, which are dependent on claim 15, these claims are patentable over the cited references for at least this reason.

Independent claim 24 recites in part a “resilient material provides the roller with properties for forming a zero seal in the absence of the instrument, and an instrument seal in the presence of the instrument”. The Examiner did not directly address the merits of claim 24; however, as discussed above, neither Gentelia nor Sleister discloses or suggests the recited feature. Accordingly, claim 24, as well as claims 25 and 31, which are dependent on claim 24, are allowable over the cited references for at least this reason.

Independent claim 47 recites in part “a roller valve disposed on an axle in the valve housing and including a compliant material, the valve having properties for forming a zero seal across the working channel in the absence of the instrument, and an instrument seal across the working channel in the presence of the instrument”. The Examiner also did not address the merits of claim 47. Applicants submit that neither Gentelia nor Sleister disclose or suggest the recited feature as discussed above. Accordingly claim 47 and claim 48, which is dependent on claim 47, are allowable over the cited references for at least this reason.

Because claims 64–66 were canceled in a paper filed August 22, 2007, the rejection is moot. Applicants bring up the rejection solely to comply with the requirement to address all pending rejections.

*Rejections over Gentelia, Sleister, and de la Torre*

Claims 16, 19, 20, and 54 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gentelia and Sleister, in view of U.S. Patent No. 6,238,373 (de la Torre). The Examiner relies on de la Torre only for disclosing a gel material.

Claims 16, 19, and 20 are dependent on claim 15. Because Gentelia and Sleister do not disclose or suggest every feature recited in claim 15, as discussed above, Gentelia, Sleister, and de la Torre also do not disclose or suggest every feature recited in claims 16 and 19. Accordingly, claims 16 and 19 are allowable over the cited references for at least this reason.

Claim 54 is dependent on claim 47. As discussed above Gentelia and Sleister do not disclose or suggest every feature recited in claim 47. Accordingly, the recited combination also does not disclose or suggest every feature recited in claim 54, and claim 54 is non-obvious over the cited references for at least this reason.

**Rejoinder of Withdrawn Claims**

As all non-withdrawn claims are allowable over the references of record, Applicants request rejoinder of claims 6, 10, 11, 13, and 14, which are dependent on claim 1, claims 26–30, which are dependent on claim 24, and claims 49–53 and 55, which are dependent on claim 47.

**No Disclaimers or Disavowals**

Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that

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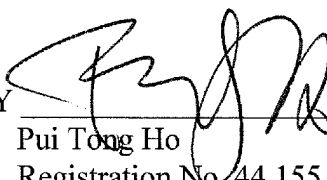
previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

### **Conclusion**

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Respectfully submitted,  
APPLIED MEDICAL RESOURCES

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